

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 08-350-WO-US)**

In application of)	
)	
Lorensten, <i>et al.</i>)	Examiner: Sheridan Swope
)	
Serial No. 10/553,869)	
)	Group Art Unit: 1652
Filed: October 21, 2005)	
)	
For: Cleavage of Fusion Protein)	Confirmation No.: 1881
Using Granzyme B Protease)	

APPLICANTS' APPEAL BRIEF

This Appeal Brief is submitted in accordance with the requirements of 37 C.F.R. 41.37 and is filed in furtherance of the Notice of Appeal filed September 3, 2009.

The required fee associated with this Appeal Brief according to 37 C.F.R. § 41.20 (b)(2) of \$540 has been paid, along with the appropriate fees for filing this brief with a four month extension of time, during the electronic filing process.

Please charge any additional fees or credit any overpayments to Deposit Account No. 132490.

TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST	1
I.	RELATED APPEALS AND INTERFERENCES.....	1
II.	STATUS OF CLAIMS	1
III.	STATUS OF AMENDMENTS	1
IV.	SUMMARY OF CLAIMED SUBJECT MATTER	1
V.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL	3
VI.	ARGUMENT	4
A.	Rejection of claims 8 and 43 under 35 USC § 112, first paragraph, enablement.	4
B.	Rejection of claims 8 and 43 under 35 USC § 112, first paragraph, written description.....	7
C.	Rejection of claims 1, 9-11, 16, 17, 40, 44-46, 50, and 51 under 35 U.S.C. 103(a) as obvious over Azad, <i>et al.</i> in view of Harris, <i>et al.</i> , and further in view of Casciola-Rosen, <i>et al.</i>	8
D.	Rejection of claims 1, 4-6, 9-11, 16, 17, 40, 41, 44-46, 50, and 51 under 35 U.S.C. 103(a) as obvious over Azad, <i>et al.</i> , Harris, <i>et al.</i> , and Casciola-Rosen, <i>et al.</i> in view of Boutin, <i>et al.</i>	16
E.	Rejection of claims 1, 9-11, 13-17, 40, and 44-51 under 35 U.S.C. 103(a) as obvious over Azad, <i>et al.</i> , Harris, <i>et al.</i> , and Casciola-Rosen, <i>et al.</i> , in view of Sigma Inc. 1998 or Pharmacia, Inc.....	18
VII.	CONCLUSION.....	19
	Claim Appendix.....	20
	Evidence Appendix.....	24
	Related Proceedings Appendix.....	25

I. REAL PARTY IN INTEREST

The real parties in interest are Anaphore, Inc. and Hoffman-La Roche Inc., the assignees of record.

I. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

II. STATUS OF CLAIMS

Claims 1, 4, 6, 8-41, and 43-51 are pending.

Claims 12 and 18-39 were withdrawn from further consideration pursuant to 37 CFR 1.142(b).

Claims 2, 3, 5, 7 and 42 are canceled.

Claims 1, 4, 6, 8-11, 13-17, 40, 41, and 43-51 are under prosecution and stand rejected and objected to.

Applicants appeal the rejections and objection to claims 1,4, 6, 8-11, 13-17, 40, 41 and 43-51.

III. STATUS OF AMENDMENTS

Applicants filed an amendment to the claims after final rejection on June 8, 2009. These amendments have been entered. *See* Advisory Action mailed June 18, 2009.

IV. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claims 1 and 40 are generally drawn to a method for preparing a polypeptide of interest in authentic form by enzymatic cleavage of fusion proteins. The method comprises a step of providing a fusion protein comprising from its N-terminal to its C-terminal, a fusion

partner, a Granzyme B protease recognition site comprising a Granzyme B protease cleavage site, and a polypeptide of interest, wherein the cleavage site is placed adjacent to the polypeptide of interest. The fusion protein is subsequently contacted with Granzyme B protease to cleave the fusion protein at the Granzyme B protease cleavage site to yield the polypeptide of interest in authentic form. *E.g.*, Specification p. 6, ll. 12-20.

Independent claim 1

The Granzyme B protease recognition site of claim 1 has the general formula “P4 P3 P2 P1 ↓” wherein P4 is amino acid I or V, P3 is amino acid E, Q, or M, P2 is X, wherein X denotes any amino acid, P1 is amino acid D, and ↓ is the Granzyme B cleavage site. *E.g.*, Specification, p. 8, ll. 21-25. In the method of the invention, the cleavage site is located adjacent the polypeptide of interest. *E.g.*, Specification, p. 7, ll. 8-24.

Granzyme B proteases are granule-stored serine proteases and include enzymes which are or may be classified under the Enzyme Commission number EC 3.4.21.79. *E.g.*, Specification p. 7, ll. 26-32.

Any suitable Granzyme B protease may be used in accordance with the invention including human Granzyme B protease, mouse Granzyme B protease and rat Granzyme B protease. Specification, p. 12, lns. 20-22.

A “fusion partner” is a peptide, oligopeptide, polypeptide or protein; *e.g.*, an affinity tag for supporting isolation of an expressed polypeptide. *E.g.*, Specification, p. 12, ll. 7-19, p. 13, ll. 20-26.

A “polypeptide of interest” is a polypeptide for which expression is desired. The specification describes a broad range of “polypeptides of interest.” *E.g.*, Specification, p. 11, lns. 4-23.

A “polypeptide of interest in authentic form” refers to a polypeptide which comprises the amino acid sequence thereof without any additional amino acid residues. To put it another way, in the present context the polypeptide of interest in authentic form refers to a polypeptide having the same primary amino acid sequence as that encoded by the gene sequence coding for the polypeptide of interest, *i.e.* it does not contain any non-native amino acids. Specification p. 6, ln. 24 – p .7, ln. 2.

Independent Claim 40

Independent claim 40 is similar to claim 1, with the primary difference being that claim 40 recites a number of specific Granzyme B cleavage sites. *E.g.*, Specification, p. 10, ln. 29 – p. 11, ln. 4.

V. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejections on appeal are as follows:

(1) Claims 8 and 43 are rejected under 35 USC § 112, first paragraph, because it is alleged that the specification does not reasonably provide enablement for the method for the preparation of a polypeptide of interest in authentic form because the skilled artisan would know that a fusion protein comprising Granzyme B and a Granzyme B cleavage motif would, more likely than not, release Granzyme B by autolysis.

(2) Claims 8 and 43 are rejected under 35 USC § 112, first paragraph, because the specification does not sufficiently describe the method for production of Granzyme B by incubating a fusion protein comprising Granzyme B and a Granzyme B cleavage site with human Granzyme B protease, wherein the added human Granzyme B releases the Granzyme B from the fusion protein by cleavage of the Granzyme B motive.

(3) Claims 1, 9-11, 16, 17, 40, 44-46, 50, and 51 are rejected under 35 U.S.C. 103(a) as obvious over Azad, *et al.* in view of Harris, *et al.*, and further in view of Casciola-Rosen, *et al.*

(4) Claims 1, 4-6, 9-11, 16, 17, 40, 41, 44-46, 50, and 51 are rejected under 35 U.S.C. 103(a) as obvious over Azad, *et al.*, Harris, *et al.*, and Casciola-Rosen, *et al.* in view of Boutin, *et al.*

(5) Claims 1, 9-11, 13-17, 40, and 44-51 are rejected under 35 U.S.C. 103(a) as obvious over Azad, *et al.*, Harris, *et al.*, and Casciola-Rosen, *et al.*, in view of Sigma Inc. 1998 or Pharmacia, Inc.

VI. ARGUMENT

A. Rejection of claims 8 and 43 under 35 USC § 112, first paragraph, enablement.

Claims 8 and 43 stand rejected for lacking enablement. According to the Examiner, the specification does not provide enablement for the claimed method because the skilled artisan would know that a fusion protein comprising Granzyme B and a Granzyme B cleavage motif would, more likely than not, release Granzyme B by autolysis (the Examiner refers to Example 3). The Examiner asserts that the method of using an exogenous Granzyme B to release the protein of interest is not enabled because the Applicants have failed to show evidence that the rate of cleavage is faster with added Granzyme B than by autolysis when compared at the same temperature. *See* Office Action mailed April 7, 2009, p. 4, and Advisory Action mailed June 28, 2009.

The Examiner's rejection for enablement is improper. The stated reason for the rejection -- that Applicants have not shown that evidence that the rate of cleavage is faster with added Granzyme B than autolysis at the same temperature -- is not accurate. For example, although

Example 3 shows autolysis of the fusion peptide comprising Granzyme B and a Granzyme B cleavage motif releases Granzyme B without addition of any previously activated Granzyme B protease, the Example also shows that such autolysis or self-activation of the Granzyme B is not completed until after a least three or four days at 4 °C. Specification p. 43, ln. 10 - p.44, ln. 2. While the specification does not provide a specific example showing the addition of Granzyme B for cleavage of a fusion partner having Granzyme B as the polypeptide of interest, numerous other examples in the Specification show that cleavage of fusion proteins that include polypeptides of interest other than Granzyme B are cleaved within a few hours by added Granzyme B. *E.g.*, p. 57, lns. 3-6, p. 58, lns. 3-7, p. 60, lns. 19-20.

The autolysis experiment described in the Specification were conducted at 4 °C (p. 43, ln. 9 – p. 44. ln. 2), while the other experiments cited above were conducted at 23 °C or “room temperature.” Therefore, the examiner emphasizes that the specification does not show an example of faster cleavage with added Granzyme B at the same temperature than cleavage by autolysis. Even without a back-to-back comparison, one of ordinary skill in the art knows that addition of enzyme to an enzyme mediated reaction would speed up the reaction. Therefore, one of ordinary skill in the art would readily understand that while autolysis of a fusion protein comprising Granzyme B and a Granzyme B cleavage site may occur, the addition of exogenous Granzyme B protease to the cleavage reaction would be expected to significantly speed up the reaction. Indeed, the specification teaches the addition of at least a “single molecule” of activated Granzyme B protease to a mixture of inactivated fusion protein. Specification p. 11, ln. 27 - p. 12, ln. 6.

Furthermore, the specification clearly demonstrates that self-activating Granzyme B protease has the advantage of being highly stable to autolysis. Specification, p. 43, ln. 10 - p. 44,

ln. 2 (for native Granzyme B); p. 46, ln. 16 - p. 47, ln. 5, Example 5 (referring to a C228F mutant Granzyme B).

The question regarding enablement can be answered by determining whether one of skill in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F. 2d 731, 737 (Fed. Cir. 1988). The burden of establishing a reasonable question of enablement rests with the Examiner. *In re Wright*, 999 F. 2d 1557, 1562 (Fed. Cir. 1993). In the present case, the Examiner's reasons for the rejection do not establish that one of skill in the art would not be able to make and use the invention without undue experimentation. The Examiner's argument appears to be that Applicants have not proven that added Granzyme B will make the cleavage reaction go faster than autolysis. Even if the Examiner's assumption is correct -- that autolysis would actually occur faster than a cleavage reaction with added Granzyme B -- this does not support a finding of non-enablement. One of skill in the art can perform a cleavage reaction with added Granzyme B and reasonably expect it to work. Indeed, several examples in the specification shows that such a cleavage reaction does work.

Indeed, while there is no example in the Specification comparing cleavage by autolysis with cleavage by added Granzyme B at the same temperature, common sense dictates that the cleavage with added Granzyme B would be faster than without. The specification discusses the addition of a "single molecule" of added Granzyme B to the mixture. Clearly, the addition of Granzyme B to the cleavage reaction is not for the purposes of slowing down the reaction, and one of skill in the art would readily understand that concept. The Examiner has not provided any evidence that the method would not work as claimed.

Therefore, the Examiner's assertion of lack of enablement is not correct since the skilled artisan would understand that exogenous Granzyme B protease could be used as a supplement to

autolysis. The skilled artisan would also be able to make and use the invention without undue experimentation.

Accordingly, Applicants respectfully request that the rejection of claims 8 and 43 under 35 USC § 112, first paragraph for lack of enablement be reversed.

B. Rejection of claims 8 and 43 under 35 USC § 112, first paragraph, written description.

The Examiner has rejected claims 8 and 43 for lacking written description because the Examiner alleges that the specification lacks written description for an embodiment of the invention wherein a fusion protein including Granzyme B and a Granzyme B cleavage site is cleaved with Granzyme B protease. The Examiner's reasons for the rejections are essentially the same as the reasons for the rejection of these claims for lack of enablement (discussed immediately above). According to the Examiner, the specification does not provide written description of the invention because "Applicants have failed to show evidence that the rate of cleavage is faster with added Granzyme B, than autolysis, at the same temperature." *See* Office Action mailed April 7, 2009, p. 5, and Advisory Action mailed June 28, 2009.

The standard for written description is whether the specification clearly allows persons of ordinary skill in the art to recognize that the inventors invented what is claimed. *In re Gostelli*, 872 F.2d 1008 (Fed. Cir. 1989). Applicants respectfully submit that the rejection is improper because the specification teaches, *inter alia*, the addition of at least a "single molecule" of activated Granzyme B protease to a mixture of inactivated fusion protein. Specification p. 11, l. 27 - p. 12, l. 6. Furthermore, the specification clearly demonstrates that self-activating Granzyme B protease has the advantage of being highly stable to autolysis. Specification p. 43,

ln. 10 – p. 44, ln. 2, Example 3 (native Granzyme B); p. 46, ln. 16 – p. 47, ln. 5, Example 5 (C228F mutant Granzyme B).

The Examiner's requirement -- that Applicants must prove that a cleavage reaction runs faster with added Granzyme B than by autolysis -- has nothing to do with the written description standard. Applicants have clearly shown that they conceived of adding Granzyme G to a cleavage reaction, even if autolysis can be expected to occur. That is all that is required for written description. Applicants do not need to prove that the invention works faster than some other embodiment in order to have adequate written description support.

Accordingly, Applicants respectfully request that the rejection of claims 8 and 43 under 35 USC § 112, first paragraph for insufficient written description be reversed.

C. Rejection of claims 1, 9-11, 16, 17, 40, 44-46, 50, and 51 under 35 U.S.C. 103(a) as obvious over Azad, *et al.* in view of Harris, *et al.*, and further in view of Casciola-Rosen, *et al.*

Claims 1, 9-11, 16, 17, 40, 44-46, 50, and 51 stand rejected under 35 U.S.C. 103(a) as obvious over Azad, *et al.* in view of Harris, *et al.*, and further in view of Casciola-Rosen, *et al.* because the Examiner alleges that it would have been obvious to a person of ordinary skill in the art to modify the fusion protein of Azad, *et al.* to incorporate the motif IEAD, as taught by Harris, *et al.* (FIG. 5D) between the GST fusion partner and nef27, and then generate nef27 by cleaving the fusion protein with Granzyme B protease. The Examiner alleges that the motivation to combine Azad, *et al.* and Harris, *et al.* derives from the desire to produce nef27. The Examiner further alleges, although incorrectly, that Applicants acknowledge that it would have been obvious to cleave a fusion protein with Granzyme B, as was known in the art (referring to Casciola-Rosen, *et al.*).

The Examiner has improperly rejected claims 1, 9-11, 16, 17, 40, 44-46, 50, and 51 under 35 U.S.C. 103(a) as obvious over Azad, *et al.* in view of Harris, *et al.*, and further in view of Casciola-Rosen, *et al.* for a number of reasons.

As a threshold matter, a claimed invention is unpatentable if the differences between it and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a); *see Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966). The ultimate determination of whether an invention is or is not obvious is based on underlying factual inquiries including: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations. *See Graham*, 383 U.S. at 17-18.

The Supreme Court emphasizes that the key of supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. *KSR Int’l Co. v. Teleflex Inc.*, 127 U.S. 1727, 1741 (2007). The Court, quoting *In re Kahn*, stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing, *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006).

At the outset, it should be appreciated that instant claims are directed to a method for the preparation of a polypeptide of interest in authentic form. In contrast, this feature of instant claims is not taught or suggested in Azad, *et al.*, or Harris, *et al.*, or Casciola-Rosen, *et al.* The failure of asserted references to teach or suggest each and every feature of instant claims is fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the

“consideration” of every claim feature in an obviousness determination. To render instant claims unpatentable, however, the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted references, individually or in combination, even if supported by the motivation to combine, must also teach or suggest each and every claim feature. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art).

In a brand new case, the Federal Circuit reiterated that in order to support a conclusion of obviousness, the combined prior art must teach all of the elements of the claimed invention. *Honeywell Int’l Inc. v. United States*, Docket No. 2008-5181 (Fed. Cir., Feb. 18, 2010). *See also In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” (emphasis in original)).

Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). MPEP § 2143 requires that the prior art provide at least a suggestion of all of the features of a claim in the prior art. This suggestion should serve as the foundation of an “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

(i) None of the cited references teach or suggest the production of a polypeptide in authentic form

At the heart of the rejection is the Examiner's conclusion that the specification teaches that "authentic form" refers to "a polypeptide having the same primary amino acid sequence as that encoded by the native gene," and the specification fails to limit the authentic form of the produced protein to having or not having an N-terminal Met. *See* Advisory Action. Although the Examiner agrees that Harris, *et al.* does not teach the production of a polypeptide in authentic form, the Examiner finds that Azad, *et al.* teaches an authentic form of nef27 protein. *See* Advisory Action.

The Examiner's conclusion is incorrect for a number of reasons. First, the definition of authentic form in the specification is clear: "authentic form" refers to a polypeptide that has "no extraneous amino acids derived from the cleavage site." Specification, p. 5, ll. 5-7. Therefore, the polypeptide of interest in authentic form refers to a polypeptide having the same primary amino acid sequence as that encoded by the gene sequence coding for the polypeptide of interest; *i.e.*, it does not contain any non-native amino acids. *Id.*, p. 6, ln. 24 - p.7, ln. 2. As a point of clarification, the specification also describes that in the claimed invention, a polypeptide of interest in authentic form is not always a polypeptide that occurs in nature, but it may also be partially or completely artificial. Specification p. 7, ll. 3-7.

There is no dispute that Harris, *et al.* does not teach the production of a polypeptide of interest in authentic form. *See* Office Action mailed April 7, 2009, p. 8. Instead, Figure 5 and the remainder of Harris, *et al.* teach the cleavage of a fusion protein to produce a pIII coat protein of M13 bacteriophage. Harris, *et al.* discloses a six amino acid motif – *e.g.*, IEAD↓AL -- that is explained as essential for Granzyme B cleavage (Abstract and Figure 5). The amino acids following the cleavage site, the P1' and P2' amino acids and a linker (AGPGGG), are not part of the authentic polypeptide sequence of the pIII coat protein of M13 bacteriophage, which is the

polypeptide of interest in Harris, *et al.*. See p. 27365, last paragraph of col. 2. Therefore, following cleavage at the cleavage site (↓), the polypeptide of interest is left with two non-authentic peptides (AL) at the N-terminus.

Also, Contrary to the Examiner's conclusion, Azad, *et al.* does not teach the production of a polypeptide of interest in authentic form. The examiner refers to p. 651, ¶ 2 of Azad for as teaching that a nef27 polypeptide contains Met-Gly at the N-terminus. See Office Action mailed April 7, 2009, p. 6 and Advisory Action. However, Azad, *et al.* teaches the production of the nef27 protein using the pGEX-2T fusion vector described in Azad, *et al.* (See p. 651, last paragraph). This vector includes a thrombin recognition sequence and cleavage site in the GST peptide encoded by the vector: Leu-Val-Pro-Arg↓Gly-Ser, wherein "↓" is the thrombin cleavage site. See Ex. A (Evidence Appendix) which is a map of the pGEX-2T vector showing the cleavage site. Therefore, the Nef protein derived from thrombin-cleaved GST-Nef (see p. 653) is left with Gly-Ser from the vector at the N-terminus. Because the Nef peptide produced as described in Azad, *et al.* has non-native amino acids left over from the vector (Gly-Ser) at the N-terminus, Azad, *et al.* does not teach the production of a polypeptide in authentic form as presently claimed.

With regard to Casciola-Rosen, *et al.*, this reference teaches a number of Granzyme B cleavage motifs, but it does not teach cleavage of fusion proteins or the production of a polypeptide in authentic form.

Therefore, none of Harris, *et al.*, Azad, *et al.*, or Casciola-Rosen, *et al.* teach the production of a polypeptide in authentic form.

- (ii) Because none of the references teach or suggest the production of the authentic form of polypeptide of interest, the reference can not be combined to render obvious the present invention.**

Harris et al. provides no reason for one of ordinary skill in the art to use its method to produce a polypeptide in authentic form as presently being claimed. Indeed, Harris, et al. teaches away from the present invention because Harris, *et al.* teaches the necessity of P1' and P2' amino acids (amino acids that are in the C-terminal direction from the cleavage site).

Furthermore, instead of teaching or suggesting the production of a polypeptide of interest in authentic form, Harris, *et al.* describes the cleavage of a variety of short synthetic amide substrates produced via a combinatorial library as shown in Tables 2 and 3. Harris, *et al.* merely identifies a handful of six amino acid sequences and the specific site of Granzyme B cleavage and provides no mention or suggestion to use Granzyme B for the purification of protein of interest in authentic form. To put it another way using the words of the CAFC in *In re O'Farrell*, Harris *et al.* gives one skilled in the art “no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful” to arrive at the claimed invention. *In re O'Farrell*, 853 F.2d 894, 895 (Fed. Cir. 1988).

Moreover, while Casciola-Rosen, *et al.* teaches a number of Granzyme B cleavage motifs, it does not teach cleavage of fusion proteins or the production of a polypeptide in authentic form. Thus, Casciola-Rosen, *et al.* does not cure the deficiencies of Harris, *et al.* and Azad, *et al.*

The Examiner has not suggested any motivation to combine any of the references except for the general overall motivation to produce polypeptides in authentic form. While Applicants do not dispute that there is a motivation for protein chemists to make pure, authentic polypeptide, the Examiner has not cited any rational reasoning why a skilled artisan would choose the method of Harris, *et al.*, which the Examiner agrees does not teach the production of a polypeptide of

interest in authentic form, to produce a nef27 polypeptide of Azad, *et al.*. The Examiner states that it would have been obvious to adapt the fusion protein to replace the GST fusion partner with an 6X-His fusion partner of Harris, *et al.*. Even doing so, however, does not render the polypeptide of interest in authentic form because, as explained above, the cleave motif of Harris does not product a polypeptide of interest in authentic form.

As recently reiterated in *Bayer Schering Pharma AG v. Barr Laboratories Inc.*, 91 USPQ2d 1569, 1573 (Fed. Cir. 2009), generalities or vague or non-existent guidance towards the claimed invention is insufficient to render a claim obvious; there must be some reason for the ordinary artisan to make the particular invention being claimed. Harris *et al.* provides no reason for one of ordinary skill in the art to use its method to produce a polypeptide in authentic form as presently being claimed.

(iii) Harris, *et al.* teaches away from the invention

While the Applicants dispute that Azad, *et al.* teach the production of a polypeptide in authentic form, even if Azad, *et al.* could be interpreted in this way, the combination of references still does not render obvious the invention.

The prior art must be considered as a whole, including portions that would lead one away from the claimed invention. *W.L. Gore & Assocs., v. Garlock, Inc.*, 721 F2d 1540 (Fed. Cir. 1983), *cert. denied* 469 U.S. 851 (1984). Indeed, Harris, *et al.* teaches away from the present invention because Harris, *et al.* teach the necessity of P1' and P2' amino acids:

[A]n optimal substrate for granzyme B was that spans over six subsites was determined to be Ile-Glu-Xaa-(Asp↓Xaa)-Gly, which cleavage of the Asp↓Xaa peptide bond. ***Granzyme B proteolysis was shown to be highly dependent on the length and sequence of a substrate.***

Abstract (emphasis added). Therefore, one of skill in the art would be led away from the present invention directed to a method wherein the Granzyme B cleavage site is “P4 P3 P2 P1 ↓”, followed polypeptide of interest in authentic form. Instead, one of skill in the art following the teaching of Harris, *et al.* and using six peptide cleave motif for which Harris, *et al.* teaches that proteolysis is **highly dependent**, would be left with a polypeptide of interest with the two amino acids following the cleavage site, P1’ and P2’, and would not have a polypeptide of interest in authentic form as claimed.

(iv) The present invention provides unexpected results

Finally, claimed invention provides unexpected results. Compared to methods of preparing fusion proteins with other proteases known in the art, Granzyme B protease provides significant and unexpected improvement over the existing cited art. Granzyme B is (a) more specific than other proteases and avoids cleavages in the middle of the protein of interest, (b) permits the purification of authentic forms of proteins of interest with no extraneous amino acids at the amino terminus thereby improving native confirmation, and (c) provides a more efficient cleavage than other proteases, which reduces production costs by reducing wasted uncleaved fusion protein. Specification, pp. 3-5, and 62. Nothing in the cited art suggests to the skilled artisan that these goals can be accomplished using a Granzyme B protease as claimed.

In light of the arguments presented above, Applicants respectfully submit that Azad, *et al.* in view of Harris, *et al.*, and further in view of Casciola-Rosen, *et al.* do not render obvious independent claims 1 and 40, and dependent claims 9-11, 16, 17, 44-46, 50, and 51.

Accordingly, Applicants respectfully request that the rejection of these claims under 35 USC § 103(a) be reversed.

D. Rejection of claims 1, 4-6, 9-11, 16, 17, 40, 41, 44-46, 50, and 51 under 35 U.S.C. 103(a) as obvious over Azad, *et al.*, Harris, *et al.*, and Casciola-Rosen, *et al.* in view of Boutin, *et al.*

For the reasons described above, claims 1, 9-11, 16, 17, 40, 44-46, 50, and 51 are not obvious over Azad, *et al.*, Harris, *et al.*, and Casciola-Rosen, *et al.* In addition, Applicants respectfully submit that Boutin, *et al.* does not add to the case of obviousness against claims 1, 9-11, 16, 17, 40, 44-46, 50, and 51. Applicants understand that the Examiner has added Boutin, *et al.* to the above-discussed rejection over Harris, *et al.*, Azad, *et al.*, and Casciola-Rosen, *et al.* in order to specifically address claims 4-6, and 41, which are directed to the use of the claimed method wherein the penultimate amino acid adjacent the cleavage site is glycine (claim 4), and polypeptide of interest is an enzyme (claims 5-6 and 41). Applicants understand that Boutin, *et al.* is not asserted as adding to the rejection over Harris, *et al.*, Azad, *et al.*, and Casciola-Rosen, *et al.* as it applies to claims 1, 9-11, 16, 17, 40, 44-46, 50 and 51.

The claims subject to the rejection over Boutin, *et al.* – claims 4-6 and 41 – depend directly or ultimately from claims 1 or 40. For the reasons stated above, the combination of Harris, *et al.*, Azad, *et al.*, and Casciola-Rosen, *et al.* does not render obvious independent claims 1 and 40. Being dependent from claims 1 and 40, claims 4-6 and 41 are not rendered obvious for the same reasons that claims 1 and 40 are not rendered obvious.

While Applicants submit that the above argument is sufficient to address this rejection, Applicants offer the following without acquiescing to the rejection over Harris, *et al.*, Azad, *et al.*, and Casciola-Rosen, *et al.* Indeed, the Examiner recognizes that Harris, *et al.*, Azad, *et al.*, and Casciola-Rosen, *et al.* does not “teach preparing a protein of interest by providing a fusion protein comprising, from the N-terminal to the C-terminal, a fusion partner, a Granzyme B cleavage motif, and the protein of interest followed by contacting the fusion protein with

Granzyme B, wherein the polypeptide of interest is an enzyme.” See Office Action mailed April 7, 2009, p. 8. To address this deficiency, the Examiner asserts that Boutin, *et al.* teaches that, like nef27 (see Azad, *et al.*), essentially all proteins that become myristoylated begin with Met-Gly at the N-terminus. The Examiner further asserts that Boutin, *et al.* teaches an enzyme, Calcineurin B, that begins with Met-Gly at the N-terminus (referring to Table 3). The Examiner points out that the N-terminal Met of Calcineurin B is removed co-translationally (referring to p. 16, paragraph 6 of Boutin, *et al.*) The Examiner concludes that it would have been obvious to a person skilled in the art to modify the fusion protein allegedly rendered obvious by the combination of Azad, *et al.* and of Harris, *et al.*, such that the nef27 protein is substituted with an enzyme, *i.e.*, calcineurin B, as taught by Boutin, *et al.*

The Examiner’s reasoning regarding the myristoylation of polypeptides and the removal of the N-terminal methionine are not relevant to the obviousness rejection. Even assuming that the Met was present, or that the protein is myristoylated, the Examiner’s only reasoning for using Boutin, *et al.* in the rejection is that one of skill in the art would be motivated to produce Calcineurin B. See Office Action mailed April 7, 2009, p. 8. Apparently, the only reason that Boutin, *et al.* is used in the rejection is related to the fact that Calcineurin is an enzyme that, assuming the Met is counted, would have a glycine that is penultimate to the N-terminus.

These reasons do not add to the case of obviousness based upon Harris, *et al.*, Azad, *et al.*, and Casciola-Rosen, *et al.*, alone, including with regard to dependent claims 4-6 and 41. With regard to claims independent 1 and 40, Boutin, *et al.* is not cited as teaching fusion proteins, any proteases cleaving fusion proteins, or the production of polypeptides using fusion proteins or proteases. Therefore, Boutin, *et al.* is irrelevant to claims 1 and 40. Therefore, the

sole fact that Calcineurin B is an enzyme would not motivate one of skill in the art combine Boutin, *et al.* with Harris, *et al.*, Azad, *et al.*, or Casciola-Rosen, *et al.*

Therefore, Boutin *et al.* does cure the deficiencies of Azad, *et al.*, Harris, *et al.*, and Casciola-Rosen *et al.* with respect to claims 1, 9-11, 16, 17, 40, 44-46, 50, and 51, and Boutin, *et al.* in combination with Harris, *et al.*, Azad, *et al.*, and Casciola-Rosen, *et al.* does not render obvious claims 4-6 and 41.

Accordingly, Applicants respectfully request that the rejection of claims 1, 4-6, 9-11, 16, 17, 40, 41, 44-46, 50, and 51 under 35 USC § 103(a) be reversed.

E. Rejection of claims 1, 9-11, 13-17, 40, and 44-51 under 35 U.S.C. 103(a) as obvious over Azad, *et al.*, Harris, *et al.*, and Casciola-Rosen, *et al.*, in view of Sigma Inc. 1998 or Pharmacia, Inc.

Sigma Inc. 1998 and Pharmacia, Inc. do not cure the deficiency of the combination of Azad, *et al.*, Harris, *et al.*, and Casciola-Rosen, *et al.* to render obvious claims 1, 9-11, 16, 17, 40, 44-46, 50, and 51, which includes independent claims 1 and 40, as discussed above. Applicants understand that this rejection is directed specifically to claims 13-15, and 47-49, which are directed to embodiments of the invention wherein the Granzyme B protease is in an immobilized form.

The Examiner acknowledges that combination of Azad, *et al.*, Harris, *et al.*, and Casciola-Rosen, *et al.* does not teach a method wherein the Granzyme B is immobilized and cites Sigma Inc. 1998 and Pharmacia Inc. as teaching the use of immobilized proteases. Based on that, the Examiner concludes that it would have been obvious to one skilled in the art to modify the method allegedly rendered obvious by the combination of Azad, *et al.*, Harris, *et al.*, and Casciola-Rosen, *et al.* to used immobilized Granzyme B. The Examiner's conclusion is incorrect.

Sigma Inc. 1998 teaches a Thrombin CleanCleave™ Kit containing Sigma's thrombin-agarose suspension used to cleave fusion proteins containing a thrombin cleavage site. Sigma Inc. 1998 further teaches that the optimal cleavage sites for thrombin are: a) P4-P3-Pro-Arg/Lys • P1'-P2', wherein P4 and P3 are hydrophobic residues, P1' and P2' are non-acidic residues and Arg/Lys • P1' is the scissile bond and b) P2-Arg/Lys • P1' where P2 or P1' is glycine and Arg/Lys • P1' is the scissile bond. Pharmacia teaches sepharose coupling gels for the immobilization of ligands via a specific functional group. However, neither Sigma Inc. 1998's description of Thrombin-Agarose suspension nor Pharmacia Inc.'s description of sepharose coupling gels teach the production of a polypeptide in authentic form as presently claimed. Thus, the addition of neither Sigma Inc. 1998 nor Pharmacia Inc. cures the deficiency of the combination of Azad, *et al.*, Harris, *et al.*, and Casciola-Rosen, *et al.* to render obvious claims 1, 9-11, 13-17, 40, and 44-51.

In light of the arguments presented above, Applicants respectfully submit that claims 1, 9-11, 13-17, 40, and 44-51 are not obvious over Azad, *et al.*, Harris, *et al.*, and Casciola-Rosen, *et al.*, in view of Sigma Inc. 1998 or Pharmacia, Inc.

Accordingly, Applicants respectfully request that the rejection of claims 1, 9-11, 13-17, 40, and 44-51 under 35 USC § 103(a) be reversed.

VII. CONCLUSION

Applicants respectfully request that the rejections of the pending claims be reversed.

Respectfully submitted,

McDonnell Boehnen Hulbert & Berghoff LLP

Date: March 3, 2010

/Patrick G. Gattari/
Patrick G. Gattari
Registration No. 39,682

CLAIMS APPENDIX

1. A method for the preparation of a polypeptide of interest in authentic form, said method comprising the steps of:
 - (i) providing a fusion protein comprising, from its N-terminal to its C-terminal, (a) a fusion partner, (b) a Granzyme B protease recognition site comprising a Granzyme B protease cleavage site that is cleavable by human Granzyme B protease, and wherein the recognition site comprises an amino acid sequence of the general formula
$$P4\ P3\ P2\ P1\ \downarrow\ (\text{SEQ ID NO: 59})$$

wherein

P4 is amino acid I or V,

P3 is amino acid E, Q or M,

P2 is X, where X denotes any amino acid,

P1 is amino acid D, and

\downarrow is said Granzyme B protease cleavage site, and
 - (c) a the polypeptide of interest, wherein said cleavage site is adjacent to the polypeptide of interest, and
 - (ii) cleaving the fusion protein with Granzyme B protease at said cleavage site to yield said polypeptide of interest in authentic form.
4. The method according to claim 1 wherein the N-terminus of the polypeptide of interest is adjacent to the cleavage site and the penultimate amino acid at the N-terminus of the polypeptide of interest is glycine.
6. The method according to claim 1, wherein the polypeptide of interest is selected from the group consisting of an enzyme, a polypeptide hormone, a single chain antibody variable region fragment, and apolipoprotein A.
8. The method according to claim 6, wherein the enzyme is Granzyme B.

9. The method according to claim 1, wherein the fusion partner is an affinity-tag.
10. The method according to claim 9, wherein the affinity-tag is selected from the group consisting of a polyhistidine-tag, a polyarginine-tag, a FLAG-tag, a Strep-tag, a c-myc-tag, a S-tag, a calmodulin-binding peptide, a cellulose-binding peptide, a chitin-binding domain, a glutathione S-transferase-tag, and a maltose binding protein.
11. The method according to claim 1, wherein the fusion protein is cleaved with a Granzyme B protease selected from the group consisting of human Granzyme B protease, mouse Granzyme B protease and rat Granzyme B protease.
13. The method according to claim 1, wherein the Granzyme B protease is in an immobilised form.
14. The method according to claim 13, wherein the Granzyme B protease is immobilised via the C-terminus.
15. The method according to claim 13, wherein the Granzyme B protease is immobilised via a lysine amino acid residue.
16. The method according to claim 10, wherein the affinity-tag is a polyhistidine-tag, and wherein the fusion protein is contacted with said Granzyme B protease in the presence of Ni^{2+} ions and Nitrilotriacetic Acid (NTA).
17. The method according to claim 16, wherein the concentration of Ni^{2+} is in the range of 1-20 mM, and the concentration of NTA is in the range of 1-20 mM.
40. A method for the preparation of a polypeptide of interest in authentic form, said method comprising the steps of:
 - a. providing a fusion protein comprising, from its N-terminal to its C-terminal, (a) a fusion partner, (b) a Granzyme B protease recognition site comprising a Granzyme B protease cleavage site that is cleavable by human Granzyme B, wherein the recognition site comprises an amino acid sequence selected from the group consisting of ICPD↓ (SEQ ID NO: 61), IEAD↓ (SEQ ID NO: 62), IEPD↓ (-SEQ ID NO: 63), IETD↓ (SEQ ID NO: 64), IQAD↓ (SEQ ID NO: 65), ISAD↓ (-SEQ ID NO: 66), ISSD↓ (SEQ ID NO: 67), ITPD↓ (SEQ ID NO: 68), VAPD↓ (-

SEQ ID NO: 69), VATD↓(SEQ ID NO: 70), VCTD↓(SEQ ID NO: 71), VDPD↓(SEQ ID NO: 72), VDS↓(SEQ ID NO: 73), VEKD↓(SEQ ID NO: 74), VEQD↓(SEQ ID NO: 75), VGPD↓(SEQ ID NO: 76), VEID↓(SEQ ID NO: 77), VRPD↓(SEQ ID NO: 78), VTPD↓(SEQ ID NO: 79), LEED↓(SEQ ID NO: 80), LEID↓(SEQ ID NO: 81), LGND↓(SEQ ID NO: 82), LGPD↓(SEQ ID NO: 83), and AQP↓(SEQ ID NO: 84), and wherein ↓ is said Granzyme B protease cleavage site, and the polypeptide of interest, wherein said cleavage site is adjacent to the polypeptide of interest, and

- b. cleaving the fusion protein at said cleavage site to yield said polypeptide of interest in authentic form.
41. The method according to claim 40, wherein the polypeptide of interest is selected from the group consisting of an enzyme, a polypeptide hormone, a single chain antibody variable region fragment, and apolipoprotein A.
43. The method according to claim 41, wherein the enzyme is Granzyme B.
44. The method according to claim 40, wherein the fusion partner is an affinity-tag.
45. The method according to claim 44, wherein the affinity-tag is selected from the group consisting of a polyhistidine-tag, a polyarginine-tag, a FLAG-tag, a Strep-tag, a c-myc-tag, a S-tag, a calmodulin-binding peptide, a cellulose-binding peptide, a chitin-binding domain, a glutathione S-transferase-tag, and a maltose binding protein.
46. The method according to claim 40, wherein the fusion protein is cleaved with a Granzyme B protease selected from the group consisting of human Granzyme B protease, mouse Granzyme B protease and rat Granzyme B protease.
47. The method according to claim 40, wherein the Granzyme B protease is in an immobilised form.
48. The method according to claim 47, wherein the Granzyme B protease is immobilised via the C-terminus.
49. The method according to claim 47, wherein the Granzyme B protease is immobilised via a lysine amino acid residue.

50. The method according to claim 44, wherein the affinity-tag is a polyhistidine-tag, and wherein the fusion protein is contacted with said Granzyme B protease in the presence of Ni^{2+} ions and Nitrilotriacetic Acid (NTA).
51. The method according to claim 50, wherein the concentration of Ni^{2+} is in the range of 1-20 mM, and the concentration of NTA is in the range of 1-20 mM.

EVIDENCE APPENDIX

Ex. A. – map of pGEX-2T vector filed by Applicants as Ex. A to Response to Office Action on June 8, 2009 and entered by the Examiner with the Advisory Action mailed June 18, 2009.



For contact information for your local office,
please visit, www.gelifesciences.com/contact

www.gelifesciences.com/pgex

GE Healthcare Bio-Sciences AB
Björkgatan 30
751 84 Uppsala
Sweden



imagination at work

GE, imagination at work and GE monogram are trademarks of General Electric Company.

A license for commercial use of GST gene fusion vectors must be obtained from Chemicon International, Incorporated, 28820 Single Oak Drive, Temecula, California 92590, USA

© 2007 General Electric Company – All rights reserved.

First published June 1993.

All goods and services are sold subject to the terms and conditions of sale of the company within GE Healthcare which supplies them. A copy of these terms and conditions is available on request. Contact your local GE Healthcare representative for the most current information

GE Healthcare Limited, Amersham Place, Little Chalfont, Buckinghamshire,
HP7 9NA, UK

GE Healthcare Bio-Sciences Corp., 800 Centennial Avenue, P.O. Box 1327, Piscataway,
NJ 08855-1327, USA

GE Healthcare Europe GmbH, Munzinger Strasse 5, D-79111 Freiburg, Germany

GE Healthcare Bio-Sciences KK, Sanken Bldg., 3-25-1, Hyakunincho, Shinjuku-ku,
Tokyo, 169-0073 Japan

RELATED PROCEEDINGS APPENDIX

None